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### **REMARKS**

In response to the Office Action mailed September 1, 2005, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file and as originally filed in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

#### **Statement of Facts**

The examiner has requested that applicant carefully review the Taheri publication, which has been made of record, but which has not been utilized in form the rejection under 35 USC §103. In addition, the examiner has requested that applicant supplement its statement as to the first publication date of the allegedly infringing pouch. Responsive to this request, attorney for applicant and applicant have carefully reviewed the Taheri publication and noted that it was filed several months after applicant began selling its rounded bottom pill crushing pouch. Neither applicant, nor attorney for applicant has any knowledge regarding the inventor, Nossi Taheri of Atlanta, Georgia.

With respect to the infringing pouch, applicant is informed and believes that Health Care Logistics, Inc. began advertising the sale of a pill crushing pouch with a curved bottom in a 2004 sales catalog that was mailed to its customers sometime in December 2003. Based upon applicant's now issued design patent, US D 497,543 issued on October 26, 2004, Health Care Logistics, Inc. has stop selling its pouch and is now selling only applicant's product.

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### Rejections

#### Rejections Under 35 USC §103

Claims 1-19 have been rejected under 35 U.S.C. §103 (a) over U.S. Patent No. 5,915,637 hereinafter called (the ***Parsons reference***) in view of U.S. Patent No. 5,059,036 hereinafter called (the ***Richison et al. reference***). Applicant respectfully traverses these rejections for the following reasons.

Applicant respectfully asserts that the Examiner has not stated a proper *prima facie* case of obviousness in support of the rejections of claims 1-19 for the following reasons. Because a proper *prima facie* case for obviousness is absent, Applicant does not at this time offer rebuttal evidence of nonobviousness for the rejected claims 1-19.

According to the Manual for Patent Examining Procedure (MPEP) § 2142, a proper *prima facie* case of obviousness can be established only when all of three basic criteria ("prongs") are met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F2d 488, 20 USPQ 2d 1438 (Fed. Cir.

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**1991).**

In rejecting claims 1-19 for alleged obviousness over the cited references, the examiner has not met the legal requirements cited in *In re Vaeck, supra*. Before discussing why the examiner has not met such legal requirements, it will be helpful to first review the two references cited by the examiner in forming the rejection.

The *Parsons reference* discloses a pill crusher that utilizes a pouch that receives a pill to be crushed. The pouch as shown in FIG. 6 of the Parsons reference is formed from a **single sheet of transparent flexible sheet material such as polyethylene**. The sheet is formed in a conventional manner to provide pouch sides, such as sides 51, a front panel 53 and a back panel 53a and a sealed bottom 55. A minor panel 52, an integral part of the front panel 53 is folded over and sealed against the back panel 53a at a straight seal line 57 to provide a leak tight container. The aforementioned panels are unsealed at their tops and an opening 58 is, thus presented. (See Col. 4, lines 27 et seq.).

The *Richison et al. reference* discloses a vented pouch arrangement which comprises a first panel section disposable self-contained device in a variety of different forms for crushing and administering pills in powder form in which a crushing surface is sealed within an envelope-like pouch formed from a tray base member and a plastic film sealed to the edges thereof, which tray contains a spoon and an edible gel in a depression, so that part of the film can be torn, a pill can be inserted into the envelope pouch and then crushed by an external crushing force. The rest of the film is removed and the pill power is then transferred to and mixed with the edible gel, and then dispensed to the patient by the spoon which is shaped so as to mated with the depression containing the edible gel and power, so the patient easily can swallow substantially all the pill powder that has been mixed with the gel. The spoon is formed

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of a hard plastic material.

Considering now the deficiencies of the examiner's rejection relative to legal requirements cited by *In re Vaeck, supra*. Regarding the first prong, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. The Examiner recites no evidence or suggestion for such combination from the prior art, despite the several motivating advantages of the combination discussed by Applicant in the present application. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure [*In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 9Fed. Cir. (1991) ]. Moreover, The level of skill in the art cannot be relied upon to provided the suggestion to combine references {*Al-Site Corp. V. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)}. Thus, Applicant respectfully asserts that there is not suggestion from combining elements from the *Parsons reference* and the *Richison et al. reference*, even in view of the present application. Neither the *Parsons reference* nor the *Richison et al. reference* consider or suggest such a combination; in fact, the *Parsons reference* considers only a pouch created from a single sheet of material with a square corner seal line and an open top for the immediate insertion of a whole pill and then its immediate removal after crushing. On the other hand, the *Richison et al. reference* is directed to a sealed vented pouch for the permanent storage of material, where the pouch is created from two separate panel sections 60 and 60 as opposed to a single sheet of material. Moreover with respect to structure at the bottom of the two separate panel sections 60 and 61, the *Richison et al. reference* provides the following at Col. 6, line 32 et seq.:

"As previously explained, each of sections 60 and 61 includes an end portion or end edge which corresponds to the end edge 53 of the overall arrangement 50. In this portion of the arrangement 50 (i.e. near edge 53), a base gusset or bottom gusset 75 is positioned. Gusset 75 includes two side panels 76 and 77 separated (when the arrangement is collapsed, FIG. 3) by a hinge fold line 78. Gusset member panel 76 is secured to panel section 60 by means such as heat sealing,

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preferably defining a curved line as shown at 79, FIGS. 3 and 4, the sealing being shown in region 80; and, gusset panel 77 is secured to panel section 61 by similar means (curved line 80a, FIG. 4). Referring to FIG. 5, when the pouch 50 is filled and expanded, the bottom gusset side panels 76 and 77 drop and form a base 81."

Clearly there is nothing in the single panel construction of the Parsons reference that would lead one skilled in the art to consider using a two panel construction with a separate and distinct gusset panel where the gusset panel is to be secured to the two separate panels by a heat seal defined by a curved line to form a single cup like seal line to provide the open pouch with a cornerless smooth rounded interior bottom. Even hindsight of having the opportunity to read the present patent application, would not lead one to combine these references as suggested by the examiner. Accordingly, the present office action does not support the first prong of a proper *prima facie* case of obviousness.

Regarding the second prong, Applicant can find no discussion of the likelihood of success (as found in the prior art) in the present office action and therefore Applicant respectfully asserts that the office action does not support the second prong for a proper *prima facie* case of obviousness.

Regarding the third prong, even when combined, the **Parsons reference** and the **Richison et al. reference** do not anticipate every element of Applicant's invention as claims in claim 1. Claim 1 as originally filed is directed to a "single sheet of flexible material" with "a cup like seal line" that is "disposed at a base portion of said front panel and said back panel to provide an open pouch with a closed bottom and an open top...". Thus, Applicant's invention provides a pill crusher pouch where the "cup like seal line" provides the "open pouch with a cornerless smooth rounded interior bottom to facilitate easy pouring of pulverized pill residue from the interior of the open pouch." The **Richison et al. reference** as noted earlier is directed to a two panel construction (panels 60 and 61) with a separate bottom gusset panel 75 that is secure to the panel

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sections by a heat seal curved line. In short the curved seal taught by the *Richison et al. reference* is to seal the bottom gusset panel 75 to the two separate panel sections 60 and 61 and not to seal the two panel together so they form a pouch with "a cornerless smooth rounded interior bottom."

More specifically, the examiner has not cited any motivation set forth in the *Parsons reference or in the Richison et al. reference* or in knowledge generally available to one of ordinary skill in the art, to modify the in the *Parsons reference and the Richison et al. reference* in the manner suggested by the examiner relative to the cited prior art as proposed or suggested by the examiner. The examiner has simply made the conclusary statement that "Richison et al. shows a similar bag including the use of a cupped bottom...and... it would be obvious for one of ordinary skill in the art to modify Parsons by providing a cup shaped bottom."

For the foregoing reasons, withdrawal of the obviousness rejection of claims 1-19 over the combination of the cited prior art is requested.

### Conclusion

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned.

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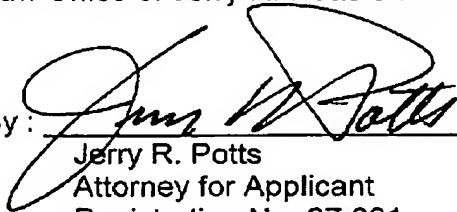
Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: November 28, 2005

Respectfully submitted,

Law Office of Jerry R. Potts & Associates

By :

  
Jerry R. Potts  
Attorney for Applicant  
Registration No. 27,091

JERRY R. POTTS & ASSOCIATES  
3248 Via Ribera  
Escondido, California 92029  
Telephone: 760-822-6201